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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,065	02/27/2004	Moses A. Lipshaw	110651-022	7359
27111	7590	07/17/2006	EXAMINER	
GORDON & REES LLP 101 WEST BROADWAY SUITE 1600 SAN DIEGO, CA 92101			PETRIK, KARI KRISTEN	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,065

Applicant(s)

LIPSHAW ET AL.

Examiner

Kari Petrik

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/31/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-42 is/are pending in the application.
- 4a) Of the above claim(s) 25-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/26/2006.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment and response to the restriction filed on 3/31/2006 have been received and made of record. As requested, claims 38, 41, and 42 have been withdrawn and claims 15, 26, 36, and 39 have been amended. Applicant has elected the claims of Group I drawn to a method and apparatus for applying compression to a limb. Claims 36, 37, 39, and 40 are drawn to a method and apparatus for applying therapeutic compression Group II, and are therefore withdrawn by the examiner being drawn to a nonelected invention. In addition, Applicant has elected species I shown in Figure 1 for examination and states claims 15-24, 26-34, 36, 37, 39, and 40 read on the elected species. It is noted that claim 26 was inadvertently identified as a generic claim when in fact claim 26 clearly does not read on Figure 1 since the bands in Figure 1 have curved edges, not straight. Therefore, claims 26-33 are withdrawn as being drawn to a non-elected species.
2. Claims 15-42 are pending in the instant application. Claims 15-24 are being examined.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carpenter et al (US Patent 6,338,723).
3. Regarding claim 15, Carpenter et al disclose a flat garment having a flat central region (42), lateral regions (41) disposed on opposite sides of the central region, and a plurality of bands extending from said opposite lateral regions. The bands comprise a planar distal region, distal and proximal, inner and outer surfaces, and a fastener. The fasteners detachably secure the distal region to a band extending from the opposite lateral region or to the central region so as to encircle the limb and to draw the first lateral region toward the second longitudinal edge to stretch the central region and thereby provide a tension in the garment that will compress the limb. Carpenter et al do not disclose each of the bands having a curved distal or proximal edge. "Curve" and "indentation" are being interpreted as equivalent since they are listed in alternative format.

A thorough reading of the specification provides no criticality to each band having a curved edge. At the time the invention was made, it would have been an obvious matter of design choice to one of ordinary skill in the art to have made all the bands having curved edges shown in Figure 1, because Applicant has not disclosed that such a design provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Carpenter et al.'s compression device and Applicant's invention to perform equally well with either the bands of Carpenter et al., or the claimed curved bands because both would perform the same function of compressing a limb. Therefore, it would have been *prima facie*

obvious to modify Carpenter et al. to obtain the invention as specified in the claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior.

4. Regarding claim 16, the central and lateral regions are biased into a three-dimensional curvature in order to fit a body part

5. Regarding claim 17, the opposing bands extend substantially perpendicular to a longitudinal axis of said central region, and the proximal and distal edges are substantially parallel (Figures 15 and 16).

3. Regarding claims 18 and 19, wrapping engagement involves juxtaposition or at least a portion of the edges and overlapping engagement of at least a portion of the upper and lower surfaces of opposing bands.

4. Regarding claim 20, the bands are spaced apart from each other and extend from each of said opposite lateral regions (Figure 16).

5. Regarding claim 21, each of said bands extend from a lateral region at an independently selected angle (Figure 18).

6. Regarding claim 22, Figure 18 shows at least one set of opposing bands extending substantially perpendicular and at least one set of opposing bands extending at a non-normal angle, wherein wrapping engagement involves overlapping engagement of at least a portion of upper and lower surfaces of opposing bands.

7. Regarding claim 23, the garment has a system for measuring compression comprising an indicia printed on the outer surface wherein measurement of a position of

at least one of the indicia relative to a reference position on the outer surface provides a measurement of the stretch of the elastic material (column 3, lines 25-45).

8. Regarding claim 24, Carpenter et al disclose using a card having a scale for measuring compression (Figures 7-9).

Response to Arguments

6. Applicant's arguments with respect to claims 15-24 have been considered but are moot in view of the new ground(s) of rejection.

7. Regarding Applicant's argument that the claim amendments get over the Carpenter reference, the examiner disagrees. The Applicant states "claim 15 limits the distal region to one that is planar, that is to say, having a surface without voids, orifices, or slots formed therethrough". A region can have voids, orifices, or slots and still be planar.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 3743

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kari Petrik whose telephone number is 571-272-8057. The examiner can normally be reached on M-Th 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

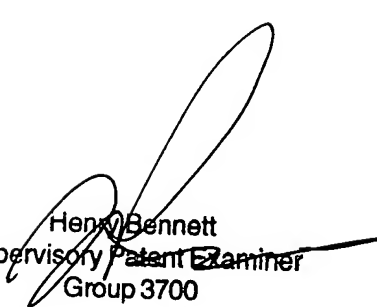
Kari Petrik

Application/Control Number: 10/789,065
Art Unit: 3743

Page 7

Examiner
Art Unit 3743

KKP



Henry Bennett
Supervisory Patent Examiner
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